

REMARKS/ARGUMENTS

Claims 1-46 are pending in this application, all of which stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,715,403 (Stefik). For the reasons set forth below, applicant respectfully submits that the claims are patentable over Stefik, and traverses the grounds for rejection.

The Stefik Patent

The Stefik patent is generally directed to a system for controlling the use and distribution of rights-managed content, where usage rights are defined by a usage-rights grammar. A “digital work” (e.g., any “written, aural, graphical or video based work that has been translated to or created in digital form”) is attached to a set of usage rights. (Stefik, col. 4, ll. 6-8.) The usage rights define how the digital work may be used and distributed. (Stefik, col. 4, ll. 11-12.) The usage rights attached to a digital work may include such rights as the right to play, print, loan, or copy the work. (See Stefik, col. 6, ll. 10-26 & FIG. 15.)

The Present Application

The present application is directed generally to the redistribution of rights managed content in a manner that is consistent with a set of license terms. As described in the application, content is distributed and associated with a license that specifies terms describing how and/or where the content may be used. (Application, p. 3, ll. 14-28.) One or more of the terms may be “redistribution” terms that specify whether the content can be re-licensed for use on other devices, and, if so, what actions (e.g., payment, etc.) are to take place upon such re-licensure. (Application, p. 3, l. 28 through p. 4, l. 15.) Thus, the license that is associated with the content specifies not only how and/or where the content may be used, but also how, and under what circumstances, the content may be re-licensed for additional usage. The claims of the present application define features relating to the above-described framework, and also define more particular features, as set forth below.

Claims 1, 14, 15, 20, 28, and 38

Claims 1, 14, 15, 20, 28, and 38 each define a license that specifies the terms or conditions on which another license may be issued. For example, claim 1 calls for a “first license” that “specifies one or more terms governing the relicensing of the first content package,” and “licensing the first content package ... in accordance with said one or more terms.” Although claims 14, 15, 20, 28, and 38 are not identical to claim 1 in either scope or language, these claims recite similar features. The cited portions of Stefik do not teach or suggest this feature.

The portions of Stefik applied to these claims by the Examiner relate to the existence of usage rights to control a digital work (Abstract); the use of a license check monitor to control the use of licensed products (col. 2, ll. 21-44); the copying or loaning of a digital work (col. 4, ll. 14-24); the structure of digital works and the billing for the use thereof (col. 9, ll. 19-31); and preventing users from making copies of digital works (col. 44, ll. 33-55). None of these cited portions discusses that the license to a digital work may specify the terms or conditions on which a further license may issue.

All of the cited portions are concerned with how a digital work may be used, copied, or loaned after it has already had usage rights or a license associated therewith. None of the cited portions teach or suggest the act of *licensing* of a digital work – much less the licensing of a digital work *in accordance with terms specified in another license*.

The Examiner has not explained how the cited portions teach the licensing of content in accordance with the terms specified in another license. However, in the rejection of these claims the Examiner appears to characterize Stefik as teaching “conditions to exercising the right or if license fees have not been paid.” In other words, the Examiner seems to view any conditions on *exercising a right* as being the same as a condition on *issuing a license*. However, exercising a right is not the same thing as issuing a license. Exercising a right means using content in accordance with an existing right; licensing content means creating data that defines a (possibly new) set of rights. Applicant respectfully submits that the Examiner has overlooked this distinction between the claims and the cited portions of the Stefik reference.

Thus, applicant submits that claims 1, 14, 15, 20, 28, and 38 are not anticipated by the cited portions of Stefik, and requests that the rejection of these claims be reconsidered and withdrawn.

Claims 4, 5, 18, 22, 23, 32, 44, and 45

Claims 4, 5, 18, 22, 23, 32, 44, and 45 each call for the collection or provision of payment as a condition for licensing content. For example, claim 4 (which is indirectly dependent on claim 1), calls for a license term that “requires collection of a payment as a condition of licensing” a content package. Claim 32 calls for “a requirement to collect payment upon creation of” a digital license, as a condition for issuing that license. Claims 5, 18, 22, 23, 44, and 45 each recite similar features. The cited portions of Stefik do not teach these features.

The Examiner cites col. 2, ll. 21-44 of Stefik as teaching the collection of payment. That portion of Stefik (which is not part of Stefik’s detailed description, but rather is Stefik’s description of a prior art PCT application (“Griswold”)) states that use of a licensed product may be denied if the license fee has not been paid; however, in the cited portion, the product is already licensed irrespective of whether the license fee has been paid. An existing license that requires continuing payment terms is not the same as a license whose issuance is conditional upon a payment. Additionally, Stefik, col. 4, ll. 21-44 states that usage right may specify “usage fees for the exercise of a right.” Applicant does not dispute that Stefik teaches that usage rights may specify fees required for the exercise of such rights. However, as discussed above, the issuance of a license is not the same as the exercise of a right, and collecting or providing payment as a condition to issue a license is not the same as charging a fee to exercise a right. The claims require the collection of a payment as part of the issuance of a license, while the cited portions of Stefik, at best, discuss payment as a condition for the exercise of a right that has already been licensed.

Thus, Stefik does not teach or suggest the features of claims 4, 5, 18, 22, 23, 32, 44, and 45, and applicant respectfully submits that the rejection of these claims must be withdrawn.

Claims 6, 19, 24, 33, and 46

Claims 6, 19, 24, 33, and 46 each call for a license term governing the creation of a further license; in particular the license term called for in these claims specifies that one license will be made unusable, or will be revoked, as a condition for issuing another license. For example, claim 6 recites that the first license contains a term governing the further licensing of content, and that term requires “revocation of the first license,” whereby the first license is made “unusable.” Claims 19, 24, 33, and 46 each recite similar features. The cited portions of Stefik do not teach or suggest these features.

It should be noted that the Examiner has not addressed these features in the Office Action. Rather, the Examiner has simply grouped claims 6, 19, 24, 33, and 36 with other claims that do not recite this feature, and has not explained how Stefik can be construed as teaching these features. Thus, the Examiner has not met the obligation to articulate the basis for the rejection of claims 6, 19, 24, 33, and 46. See MPEP 706 (“The goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise respond completely at the earliest opportunity.”) Moreover, the undersigned has reviewed the cited portions of Stefik, and has found no materials relating to the revocation of a license, or the act of making a license unusable, and thus the cited portions of Stefik cannot be found to anticipate claims 6, 19, 24, 33, and 46.

Thus, Stefik does not teach or suggest the features of claims 6, 19, 24, 33, and 46, and applicant respectfully submits that the rejection of these claims should be reconsidered and withdrawn.

Claim 8

Claim 8, which is dependent on claim 1, calls for “creating a second license,” “transmitting ... said second license” to a first computing device, where “the first computing device associates said second license with the first content package.” It should be noted that no association exists between the second license and the first content package at the time that the

second license arrives at the first computing device; this is why the first computing device performs the act of making such an association, as called for in claim 8.

In Stefik, by contrast, usage rights and digital works are attached. (See Stefik, col. 6, ll. 62-63.) Moreover, in the particular portion of Stefik that the Examiner has cited against claim 8 (col. 7, ll. 16-48), a digital work arrives at a repository with its usage rights already associated or attached. The cited portion of Stefik does not describe a case where usage rights or a license arrive at a computing device separate from content, such that the receiving computing device needs to associate the rights with the content. On the contrary, in Stefik that association is already made before the rights and the work travel to a receiving device.

Thus, Stefik does not teach or suggest the features of claim 8, and applicant respectfully submits that the rejection of claim 8 must should be reconsidered and withdrawn.

Claim 37

Claim 37 is dependent on claim 28. Claim 28 defines a first license that permits the creation of a second license. The first license allows the content to be used on a first computing device, and the second license allows the content to be used on a second computing device. Moreover, claim 37 specifies that “the second license does not permit licensure of the digital content item for usage on a third computing device different from the first computing device and second computing device.” In other words, with claim 37 the “buck stops” at the second computing device, since the license that is valid on the second computing device does not permit licenses for the content to be distributed any further down the distribution chain.

Stefik simply does not teach or suggest this model. Stefik permits digital works to be used at repositories, and permits works to be copied and loaned between repositories as described above, but saying nothing about cutting short a distribution chain where licensure is permitted on the first and second device in the chain, but not on any third device.

Thus, Stefik does not teach or suggest the features of claim 37, and applicant respectfully submits that the rejection of claim 37 should be reconsidered and withdrawn.

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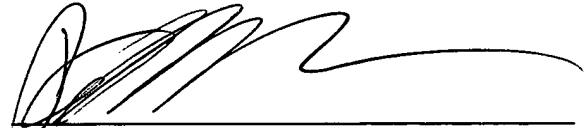
Drawings

The Examiner has not indicated whether the formal drawings filed with this application have been accepted. It is requested that, in the next action, the Examiner indicate acceptance of the formal drawings filed with this application.

Conclusion

As set forth above, claims 1, 4-6, 14, 15, 18-20, 22-24, 28, 32, 33, 38, and 44-46 have been shown to be patentable over Stefik, as applied. Moreover, claims 2, 3, 7-13, 16, 17, 21, 25-27, 29-31, 34-37, and 39-43 are dependent, either directly or indirectly on one or more of claims the above-listed claims, and thus are patentable at least by reason of their dependency. Thus, all claims have been shown to be patentable. Applicant respectfully requests that the rejection of claims 1-46 be withdrawn, and that a Notice of Allowance be issued.

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Peter M. Ullman
Registration No. 43,963

Woodcock Washburn LLP
One Liberty Place - 46th Floor
Philadelphia PA 19103
Telephone: (215) 568-3100
Facsimile: (215) 568-3439